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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

NUTTER, NATHAN M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1711

DATE MAILED: 04/16/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,230

Applicant(s)

WILLIAMS ET AL.

Examiner

Nathan M. Nutter

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-- Th MAILING DATE of this communication app ars on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group V, claims 27-33, in Paper No. 10 of 25 March 2003 is acknowledged. The traversal is on the ground(s) that

1) "the Group I and Group VI claims are so closely related that the search for each claim will overlap", and

2) "Applicants submit that upon a determination of allowable subject matter in the Group V claims, the Group I-IV and VI claims must be joined". This is not found persuasive because:

1) the Group I invention is drawn to a "method of making an elastomeric formulation", but the Group I method does not make the composition of the Group VI invention, since the Group I invention produces a neutralized composition, the Group VI invention requires a pH of "between about 8 and 10". Further, the search areas do not overlap, the Group I invention is classified in Class 525, and the Group VI claims are classified in Class 524.

2) The elected Group V invention is drawn to an after-treated polymer composition. The Group I invention is drawn to a method of making the Group V invention. The Group II invention is drawn to a method of producing an article, not to a method of making or a method of using the elected composition. The Group III claims are drawn to an article, not a method of use of the composition of Group V. the Group IV claims are drawn to a method of making an article, not a method of making or a method of use of the elected composition. ONLY Group I would be considered for

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rejoinder to the elected claims, and only after the indication of allowable subject matter of the Group V claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The recitation in claim 27 of “a base polymer having carboxyl groups” is not enabled by the teachings of the Specification at page 4, 5th full paragraph. That section recites monomers acrylonitrile and isoprene as though they are polymers. Butadiene rubber, neoprene and natural latex rubber do not have carboxylate groups, yet are intended for inclusion of applicants’ definition for “a base polymer having carboxyl groups”. The determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claim 27 of “a carboxylic acid or derivative thereof” is not enabled by the teachings of the Specification at page 5, 1st full paragraph, since the term is used in derogation of its meaning. The term “carboxylic acid” embraces a class of compounds that may include amino acids

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and other species either not suitable nor compatible for inclusion. No clear criterion is expounded herein. The Specification, further, states that “(d)erivatives of carboxylic acid include...copolymers, blends and mixtures”. A copolymer is NOT a derivative. Again, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claim 27 of “a divalent or trivalent metal” is not enabled by the teachings of the Specification at the paragraph bridging page 5 (line 37) to page 6 (line 34) of the Specification since the term is used in derogation of its meaning. The Specification indicates the addition of metal ions and not of metal, *per se*. Again, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claim 27 of “an amine or amino compound” is not enabled by the teachings of the Specification at the paragraph bridging page 6 to page 7 of the Specification since the term is not clearly discussed as to constitution, but, rather as to function, “capable of adjusting the pH of the latex”. As such, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. The further, recitation of “a neutralizing agent” is not enabled by the teachings of the Specification at the paragraph bridging page 4 to page 5 since the term is not disclosed as to its meaning.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are not clear as to their proper metes and bounds since the terms "a base polymer having carboxyl groups", "a carboxylic acid or derivative thereof", "a divalent or trivalent metal", "an amine or amino compound" and of "a neutralizing agent" are not clear as to either their content or scope as to what may or may not be included. As such, these claims are deemed to be vague and confusing.

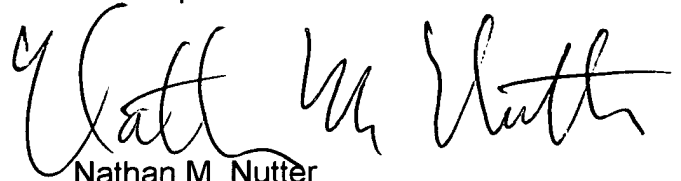
The references to Quigley et al ('367), Rowland et al ('635) and Sullivan et al ('803), all cited by applicants are retained as of interest, but are not deemed to negate the patentability of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Nathan M. Nutter". The signature is fluid and cursive, with the first name "Nathan" being the most prominent part.

Nathan M. Nutter
Primary Examiner
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nmn
April 15, 2003